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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848
25247 7590 07/22/2008 GORDON E NELSON PATENT ATTORNEY, PC 57 CENTRAL ST PO BOX 782 ROWLEY, MA 01969				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3626				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/730,299

Applicant(s)

FALCHUK ET AL.

Examiner

Natalie A. Pass

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 16 April 2008. Claims 1-4 remain pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for substantially the same reasons given in the previous Office Action (paper number 20071101).

(A) Claims 1-4 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20071101, section 5, pages 2-4), and incorporated herein.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing medical education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities', Proceedings of the National Forum 27-29 March 1995. URL:
<<http://ieeexplore.ieee.org/iel3/3745/10944/00504546.pdf?tp=&number=504546&isnumber=10944>>, hereinafter known as Fontelo, for substantially the same reasons given in the previous Office Action (paper number 20071101). Further reasons appear hereinbelow.

(A) Claims 1-2 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20071101, section 8, pages 4-6), and incorporated herein.

6. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing Medical Education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities.', Proceedings of the National Forum, 27-29 March 1995. URL:
<<http://ieeexplore.ieee.org/iel3/3745/10944/00504546.pdf?tp=&number=504546&isnumber=10944>>, hereinafter known as Fontelo, as applied to claims 1 and 2 above, and further in view of Galewitz, P., Doctors Can Now Get Continuing Education On-Line. Palm Beach Post. Jul 8, 1996. URL:

<<http://proquest.umi.com/pqdweb?did=66323909&sid=4&Fmt=3&clientId=19649&RQT=309&VName=PQD>>, hereinafter known as Galewitz, , for substantially the same reasons given in the previous Office Action (paper number 20071101). Further reasons appear hereinbelow.

(A) Claims 3-4 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20071101, section 9, pages 6-8), and incorporated herein.

Response to Arguments

7. Applicant's arguments on pages 3-6 of the response filed 16 April 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 16 April 2008.

(A) On pages 3-4 of Applicant's response filed 16 April 2008 Applicant argues the rejection of claims 1-4 under 35 U.S.C. § 112, first paragraph, for reciting limitations that are new matter, and presents arguments related to references in U.S. Patent 6, 256, 613, of which the present application is a divisional. Applicant's arguments have been fully considered but they are not persuasive.

At lines 34-37 on page 3 of the 16 April 2008 response Applicant argues the 35 U.S.C. § 112, first paragraph rejection, claiming that the limitation of "certifying that the first physician is entitled to the continuing medical education credit in a database accessible from the intermediary," as recited in claim 1, is disclosed in Figure 1, Item 82 and in column 5, lines 63-67 of U.S. Patent 6, 256, 613. Examiner respectfully disagrees. Although the figure shows

generation of a report from the continuing medical education database and although column 5, lines 47-67 discloses an “accreditation module” and a database which “produces accreditation reports ... [...] ... which may be submitted to the responsible accreditation authority,” (Examiner interprets “responsible accreditation authority” to be a form of “intermediary”), Examiner does not interpret submission of accreditation reports to a “responsible accreditation authority” (i.e. “intermediary”) to mean that the database is accessible from the intermediary.

At lines 13-18 on page 4 of the 16 April 2008 response Applicant argues the 35 U.S.C. § 112, first paragraph rejection, claiming that the limitation of “performed in the intermediary under supervision of the medical information specialist” as recited in claims 2-4, is disclosed in Figure 1, and at column 3, line 49 to column 4, line 19 and at column 5, lines 48-67 of U.S. Patent 6, 256, 613. Examiner respectfully disagrees. Although the figure shows selecting a specialist, and although column 3, line 40 to column 4, line 19 and column 5, lines 48-67 disclose “selection of one or more specialists having expertise in the specialty in which consultation is sought” and selecting “a specialist” and forwarding the request together with materials from an information database “to the selected specialist,” and an “accreditation module” and a database which “produces accreditation reports ... [...] ... which may be submitted to the responsible accreditation authority,” (Examiner interprets “responsible accreditation authority” to be a form of “intermediary”), Examiner does not interpret these teachings to teach the limitation of “performed in the intermediary under supervision of the medical information specialist.”

As an additional note, Examiner notes that the references cited above, in United States Patent Number 6, 256, 613, refer to a medical specialist having expertise in a medical specialty, and not to a “medical information specialist” which Examiner interprets to be a broader term than a medical specialist, encompassing any specialist in “medical information.” For example, Examiner interprets a “medical information specialist” to broadly define someone who specializes in the handling of medical information, including, for example, a secretary or administrator who records relevant medical information.

(B) At pages 4-6 of the 16 April 2008 response Applicant argues the 35 U.S.C. § 103 rejection, claiming that the features claimed in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as obvious in view of the combined teachings of Fontelo and Galewitz, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20071101), and incorporated herein. In particular, Examiner notes that the features of “providing continuing medical education credit to a first physician for a consultation between the first physician and a second physician” as recited in the preamble of claim 1 are taught by the applied references (Fontelo; Figure 1, Figure 2A, page 141, column 1, paragraph 3, paragraph bridging page 141 column 2 and page 142, column 1, page 142, column 2, paragraph 1); Examiner interprets the word “consultation” broadly, and interprets Fontelo’s teachings of “[t]he primary goal of the project is to provide CME [continuing medical education]

to ... [...] ... physicians and allied medical practitioners... [...] ... ” and “a forum for exchanging diagnostic opinions on ... [...] ... cases from other pathologists or diagnosticians ... [...] ... ” (Fontelo; paragraph bridging page 141 column 2 and page 142, column 1), and Fontelo’s teachings of “[p]articipants must return a question and evaluation form to USUHS to receive credit” (Fontelo; Figure 2A, page 142, column 2, paragraph 1) and “[t]he established method of earning CME credit has been through participation in conferences, seminars, meetings, and workshops sponsored by academic institutions [reads on “arranging and arranging and conducting the consultation under supervision of a medical information specialist in the intermediary who is neither the first nor the second physician”]” (emphasis added) (Fontelo; page 141, column 1, paragraph 3) to teach a form of “providing continuing medical education credit to a first physician for a consultation between the first physician and a second physician.” Examiner further notes that CME departments of academic institutions are well-known in the art, and that these departments employ “medical information specialists” who arrange and conduct the accreditation meetings or consultations. Moreover, Examiner interprets a “medical information specialist” to broadly define someone who specializes in the handling of medical information, including, for example, a secretary or administrator who records relevant information; and Examiner further notes that it is well-known that intermediaries such as “academic institutions” which enable participation in conferences, seminars, meetings, consultations, and workshops and which give CME credits, utilize medical information specialists to record relevant information, such as comments and consultations, for determination of CME credits.

With regard to Applicant's argument at page 5, paragraph 2 of the 16 April 2008 response that the Fontelo reference fails to describe "a *medical consultation* which is arranged and conducted by an intermediary ... [...] ...," Examiner notes that this is not a claimed limitation.

With respect to Applicant's argument at page 5, paragraph 2 of the 16 April 2008 response that a *prima facie* case of obviousness has not been established the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 20071101) and present Office Action) have been expressly articulated.

With regard to Applicant's arguments in the paragraph bridging pages 5-6 of the 16 April 2008 response, these issues have been discussed earlier in this Office Action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please label

"PROPOSED" or "DRAFT" on the front page of the

communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The

examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. A. P./
Examiner, Art Unit 3626
July 9, 2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626